

REMARKS

Applicant requests reconsideration and allowance of the present application in view of the foregoing amendments and the following remarks.

Claims 1-11 are pending in the present application. Claims 1, 3, 5, 8, and 11 are the independent claims.

No claims have been amended.

The Office Action objected to FIG. 3 of the drawings on formal grounds. By the present Amendment, Applicant has filed a Replacement Drawing Sheet bearing a FIG. 3 amended in view of the Examiner's comments.

Favorable consideration is respectfully requested.

Claims 1-11 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Publication No. 2003/0023761 (Jeansonne et al.) in view of U.S. Patent Publication No. 2003/0126492 (Cavin).

All rejections are respectfully traversed because the Office has failed to make out a prima facie case of obviousness.

Section 2142 of the Manual of Patent Examining Procedure (MPEP) explains that a prima facie case of obviousness requires that there be some suggestion or motivation, either in the references themselves or in the knowledge of one of ordinary skill in the art, to modify combine reference teachings. It is for this reason that the mere fact that a combination can be made is legally insufficient to support an obviousness rejection. (MPEP, § 2143.01). And, the Office bears the initial burden of factually supporting any prima facie conclusion of obviousness.

If the Office does not produce a prima facie case, the Applicant is under no obligation to submit evidence of nonobviousness. (MPEP, § 2142). Applicants respectfully submits that such is the case in the present application.

The primary citation to Jeansonne et al. relates to a wireless access point seek mode for wireless access clients and discusses an arrangement whereby a user of a notebook system can search for the availability of wireless access points when the notebook computer system is not powered on. In operation, when the user presses a specified button, a seek logic 60 initiates a wireless access point seek mode and enables a power supply 40, which powers a wireless communication module 42 to perform the seek function. (Jeansonne et al., Abstract, [0043]-[0044]; FIGS. 2 and 3). Jeansonne et al. expressly teaches that the execution of the seek

function involves the execution of software programs by a microcontroller 44. (Jeansonne et al., paragraph [0045]). Thus, Jeansonne et al. expressly teaches that the search for the availability of wireless access points is achieved by a microcontroller executing software.

The secondary citation to Cavin relates to increasing data throughput on a wireless local area LAN in the presence of intermittent interference and discusses a software stack that includes BIOS/firmware 306 that can access a wireless interface layer 310. (Cavin, FIG. 3). Cavin goes on to explain that the BIOS/firmware can be used instead of application software to "make wireless connections" and that a medium access controller (MAC), which serves as an interface between the software and hardware required for wireless communication, resides in the BIOS/firmware. (Cavin, paragraph [0037]). Thus, Cavin expressly teaches using a MAC residing in BIOS/firmware to "make wireless connections."

Applicant respectfully submits that neither Jeansonne et al. nor Cavin expressly or impliedly suggest the asserted combination. Indeed, Applicant notes no such contention in the Office Action. Thus, as part its initial burden to establish a prima facie case of obviousness, the Office "must present a convincing line of reasoning as to why the artisan would have found the claimed invention to be obvious in light of the teachings of the references. MPEP, § 2142, citing Ex parte Clapp, 227 USPQ 972, 973 (Bd. Pat. App. & Inter. 1985).

The Office Action provides a single line of reasoning for the alleged motivation to make the asserted combination. Specifically, at pages 4-7 and 9 of the Office Action, it is repeatedly asserted that one of ordinary skill in the art would have been motivated to modify Jeansonne et al. in view of Cavin because:

"it would have been obvious to a person of ordinary skill in the art at the time the invention was made to modify the teachings of Jeansonne et al. with the teachings of Cavin in order to perform a wireless network search without turning the system power on and thereby conserving power in a situation where finite power is available."

Thus, it is asserted that one of ordinary skill in the art would have been motivated to modify Jeansonne et al.'s teaching of using a microcontroller to execute software to search for the availability of wireless access points in view of Cavin's teaching of using a MAC residing in BIOS/firmware to "make wireless connections" in order to perform a wireless search without turning on the system power and thereby conserve power."

This line of reasoning, however, does not meet the MPEP's required standard of "convincing" because Jeansonne et al. achieves this result without the asserted modification

(See, e.g., Jeansonne et al., Abstract). Stated another way, the capability to “perform a wireless search without turning on the system power” is already provided by Jeansonne et al. alone. Further, Jeansonne et al. teaches that an advantage of this capability is to conserve power. (See, e.g., Jeansonne et al., [0009] – [0011]). Consequently, the Office Action fails to provide the required “convincing line of reasoning” required by the MPEP.

The absence of this convincing line of reasoning and any other suggestion for the asserted combination precludes a prima facie case of obviousness. For at least this reason, the rejection of independent claims 1, 3, 5, 8, and 11 under 35 U.S.C. § 103 are respectfully traversed. (See, MPEP, § 2142)

Accordingly, favorable reconsideration and withdrawal of the rejection of the claims under 35 U.S.C. § 103 are respectfully requested.

In view of the foregoing, Applicant respectfully submits that the independent claims patentably define the present invention over the citations of record. Further, the dependent claims should also be allowable for the same reasons as their respective base claims and further due to the additional features that they recite. Separate and individual consideration of the dependent claims is respectfully requested.

Applicant believes that the present Amendment is responsive to each of the points raised by the Examiner in the Official Action. However, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to such matters.

There being no further outstanding objections or rejections, it is submitted that the present application is in condition for allowance. An early action to that effect is courteously solicited.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

STAAS & HALSEY LLP

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By: Mr. Kondoudis

Michael E. Kondoudis
Registration No. 42,758

1201 New York Avenue, NW, Suite 700
Washington, D.C. 20005
Telephone: (202) 434-1500
Facsimile: (202) 434-1501

AMENDMENTS TO THE DRAWINGS

The attached drawing sheet includes an amended FIG. 3. Specifically, the word "MERORY" in block S5 has been changed to "MEMORY" and the words "DETERMINES" and "LAND" in block S7 have respectively been changed to "DETERMINE" and "LAN". The changes to words "MERORY" and "LAND" are being made in response to an objection based on the same in the Office Action. The change to "DETERMINE" is being made solely to improve the form of the text. The attached drawing sheet replaces the corresponding drawing sheet presently of record for the subject application. These amendments do not introduce new matter.